

REMARKS

Claims 1, 3-30 and 33-42 are pending. Claims 2, 31 and 32 are canceled. Claims 1 and 30 have been amended herein. No new matter is added by these amendments. Support for the amendments to Claims 1 and 30 can be found at least at page 5, lines 2-6 and page 11, lines 15-18 of the specification as filed, and by Claim 29 as filed.

CLAIM REJECTIONS - 35 U.S.C. §103(a)

I. Hunt in view of Williams

The instant Office Action states that Claims 1, 3-19, 26-28, 30, 33-35 and 37-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hunt et al. (U.S. Patent No. 5,835,716; hereinafter “Hunt”) in view of Williams et al. (U.S. Patent No. 6,560,509; hereinafter “Williams”) and in further view of Theil (U.S. Patent No 6,035,291, hereinafter “Theil”). Applicants have reviewed the above-cited art and respectfully submit that the embodiments as recited in Claims 1, 3-19, 26-28, 30, 33-35 and 37-39 are patentable over Hunt in view of Williams and Theil for at least the following rationale.

A. Claims 1, 3-19, 26-28, 30, 33-35 and 37-39

Independent Claim 1 recites the features (emphasis added):

1. An information exchange system comprising:
a link to a communication network coupled to a plurality of partner databases storing information related to carrier availability;
a database coupled to said link, said database storing a demand entry and a plurality of carrier entries that arrive to said database through said communication network, said demand entry comprising shipping demand specifications and said plurality of carrier entries comprising carrier availability information; and
a logic unit coupled to said database, said logic unit receiving said demand entry, automatically selecting one of said plurality of carrier entries based on an attribute of said demand entry, and automatically booking said selected carrier entry in response to said demand entry.

Claim 30 recites similar features. The Applicants submit that the features recited in independent Claims 1 and 30 are not rendered obvious by Hunt in view of Williams and/or Theil. More specifically, neither Hunt, Williams, nor Theil is understood to disclose a plurality of partner databases storing information related to carrier availability which are coupled with a database which stores a demand entry and a plurality of carrier entries that arrive to the database as recited in Claims 1 and 30. The instant Office Action states, “Hunt discloses the use of a partner subsystem (9) with a request database, that is different from the transportation database, and which ports data to the centralized database, which stores demand specification information, See Claims 6-9, Column 4, lines 45-62.” The Applicants submit that this interpretation of the cited art is in error. Hunt discloses in Column 4, lines 45-48 (emphasis added): “Subsystem 9 represents an input/output point at a carrier or shipper site that is porting data to centralized database 50 which can be administered by the carrier, shipper, or a third party.”

The Applicants do not understand Hunt to disclose or imply that either of subsystems 8 or 9 of Figure 1A comprises a partner database storing information related to carrier availability as recited in Claims 1 and 30 of the present invention. Instead, the Applicants understand Hunt to disclose the use of a single centralized database 50 with which user terminals (e.g., subsystems 8 and 9 of Figure 1A) are coupled. More specifically, the Applicants submit that one skilled in the art would not equate an input/output point as disclosed by Hunt with the partner databases recited in Claims 1 and 30.

“As reiterated by the Supreme Court in KSR, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)).

The Applicants submit that Williams and Theil both fail to overcome the shortcomings of Hunt. The Applicants do not understand either of Williams or Theil to disclose a plurality of partner databases storing information related to carrier availability which are coupled with a database which stores a demand entry and a plurality of carrier entries that arrive to the database as recited in Claims 1 and 30. Therefore, the Applicants submit that Hunt alone, or in combination with Williams and/or Theil, fails to teach or suggest a plurality of partner databases storing information related to carrier availability which are coupled with a database which stores a demand entry and a plurality of carrier entries that arrive to the database as recited in Claims 1 and 30. Furthermore, the rejection fails to explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” as directed under MPEP 2141(III).

Furthermore, the Applicants submit that Hunt teaches away from the combination set forth in the instant rejection. Again, the Applicants understand Hunt to teach:

The system operator selects an appropriate matched entry which must then be confirmed. Upon confirmation, selected matches are saved to a transaction database and assigned a transaction code.

Abstract of Hunt (emphasis added); see also, Figure 3B steps 218 and 220; Figure 3C step 242; col. 9, lines 21-24; and col. 9, lines 10-14. Applicants understand Williams to teach “[t]he particular order may be automatically assigned to a carrier” Abstract of Williams (emphasis added).

The instant Office Action states:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of selecting and booking a carrier of Hunt, to be automated as disclosed as Williams, because the use of known techniques of automating the selection and booking of a carrier would have been obvious to one of ordinary skill in the art.

See the instant Office Action, page 4, section 6.

Applicants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination.” MPEP § 2145(X)(D)(2) (emphasis added), citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02(VI) (emphasis in original), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Applicants respectfully submit that there is no motivation to modify Hunt in view of Williams and/or Theil at least because Hunt specifically teaches away from the suggested modifications. Moreover, Applicants note: “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious” (emphasis added) (MPEP 2143.01; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

In particular, the Applicants respectfully submit that the requirement of Hunt that, subsequent to “operator selection” of “an appropriate matched entry”, the selected entry “must then be confirmed” (Abstract of Hunt (emphasis added)) teaches away from the modification of automatically selecting as recited in Claims 1 and 30 of the present invention. The Applicants submit that Hunt specifically teaches away from this recited feature in column 8, lines 22-24 in which it is stated that: “the system operator can scroll up or down the list and select an appropriate route....” Similarly, column 9 lines 10-14 state that the system operator selects the match.

Similarly, the Applicants respectfully submit that the requirement of Hunt that subsequent of selecting a route(s), a query is made as to whether a selected route is to be confirmed (see column 9, lines 18-40) teaches away from the recited feature of

automatically booking a selected entry as recited in Claims 1 and 30. Indeed, Applicants respectfully submit that a process or system of “automatically selecting...” and “automatically booking...” a selected entry, as recited in Claim 30 and similarly in Claim 1, necessarily precludes execution of the step of an operator selecting an entry and entering the selection and the step of receiving confirmation of a selected entry, as required by Hunt (Abstract of Hunt see also, Figure 3B steps 218 and 220; Figure 3C step 242; col. 9, lines 21-24; and col. 9, lines 10-14). Thus, the combination of Hunt with Williams and/or Theil would change the principle of operation of the invention of Hunt. In the response to arguments section (section 38, pages 9 and 10) of the previous office action (mailing date of 8/07/2008), it was argued that, “Hunt ...never discloses who does the confirming.” However, it is clear from the language of Hunt that a system operator does the selecting, (see, col. 5, lines 61-65, col. 8, lines 22-24, col. 9, lines 21-24 and col. 9, lines 10-14 of Hunt). Specifically, in col. 8, lines 22-24 and col. 9, lines 10-14, Hunt discloses that the system operator selects the match. Because Hunt is not understood to disclose that the system receives confirmation or selection events from any entity other than the system operator in the rest of the disclosure, the Applicants submit that Hunt implies that other queries initiated by the system are confirmed by the system operator. Thus, automatic selection and booking of carrier entries as recited in Claims 1 and 30 would change the principle of operation disclosed by Hunt.

Thus, the Applicants submit that the proposed modification of Hunt by the disclosure of Williams and/or Theil is improper in light of the requirements under MPEP § 2145(X)(D)(2) and MPEP 2143.01. For at least the foregoing rationale, Applicants respectfully submit that Claims 1 and 30 are patentable over Hunt in view of Williams and in further view of Theil and that these claims overcome the rejection under 35 U.S.C. §103(a). Accordingly, the Applicants submit that the rejection of Claims 1 and 30 under 35 U.S.C. §103(a) is not supported by the cited art.

Claims 3-19 and 26-28 depend from Claim 1 and recite additional features descriptive of embodiments of the present invention. Accordingly, the Applicants submit

that the rejection of Claims 3-19 and 26-28 under 35 U.S.C. §103(a) are also not supported by the cited art.

Claims 33-35 and 37-39 depend from Claim 30 and recite additional features descriptive of embodiments of the present invention. Accordingly, the Applicants submit that the rejection of Claims 33-35 and 37-39 under 35 U.S.C. §103(a) are also not supported by the cited art.

B. Claims 5 and 34, Unsupported Official Notice

The foregoing notwithstanding, the instant Office Action states:

Hunt ... fails to disclose the logic unit allows a user to define a subgroup within the exchange system, and assign unrestricted access to only members of the subgroup. The examiner takes official notice that the use of defining a group who has unrestricted access to the system is old and well known in the art.

See the instant Office Action, page 8, section 28 (emphasis added).

Applicants respectfully submit that the instant Office Action has provided inadequate support of a finding of Official Notice.

The “assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.” MPEP § 2144.03(A), citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Indeed, “[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.” MPEP § 2144.03(E), citing *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970)). Per MPEP §2144.03 (A), “...assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art” (emphasis added). In re

Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21. See also In re Grose, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Per this guidance of the MPEP, Applicants submit that the Office Action has inappropriately taken official notice of technical facts or specific knowledge without providing support by citation to a reference work recognized as standard in the pertinent art. Applicants submit that proper support must be given in order for Applicants to determine an appropriate response, if any. The Office Action appears to be attempting to shift the burden of response to the Applicants prior to and without satisfying the Office's initial burden of citation of support. Accordingly, Applicants respectfully request that the Examiner provide adequate evidence in the form of an affidavit in support of the finding of Official Notice, in accordance with 37 CFR § 1.104(d)(2) or a citation which supports the Official Notice, or withdraw the objections to Claims 5 and 34.

II. Hunt in view of Williams and in further view of Nel

The instant Office Action states that Claims 20-25, 29, 36 and 40-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hunt in view of Williams, and in further view of Nel (U.S. Patent Application Publication No. 2003/0036935). Applicants have reviewed the above-cited art and respectfully submit that the embodiments as recited in Claims 20-25, 29, 36 and 40-42 are patentable over Hunt in view of Williams, and in further view of Nel, for at least the following rationale.

Claims 20-25 and 29 are dependent on independent Claim 1 and include the features of Claim 1. Claims 36 and 40-42 are dependent on independent Claim 30 and include the features of Claim 30. Hence, by demonstrating that Hunt in view of Williams does not teach or suggest the features of a plurality of partner databases storing information related to carrier availability which are coupled with a database which stores a demand entry and a plurality of carrier entries that arrive to the database as recited in Claims 1 and 30, it is demonstrated that Hunt in view of Williams does not teach or suggest the embodiments of Claims 20-25, 29, 36 and 40-42. The Applicants submit that

Nel fails to overcome the shortcomings of Hunt alone, or in combination with Williams. More specifically, Nel does not disclose a plurality of partner databases storing information related to carrier availability which are coupled with a database which stores a demand entry and a plurality of carrier entries that arrive to the database as recited in Claims 1 and 30 of the present invention. Hence, by demonstrating that Hunt in view of Williams, and in further view of Nel, does not teach or suggest the features of Claims 1 and 30, it is demonstrated that Hunt in view of Williams, and in further view of Nel, does not teach or suggest the embodiments of Claims 20-25, 29, 36 and 40-42.

Independent Claim 30, and similarly independent Claim 1, recites the features (emphasis added):

A method comprising:

...

automatically selecting one of said plurality of carrier entries based on an attribute of said demand entry; and
automatically booking said selected carrier entry in response to said demand entry.

As stated above, Applicants respectfully submit that there is no motivation to modify Hunt in view of Williams at least in part because Hunt teaches away from the suggested modification. Additionally, the modification proposed in the rejection would change the principle of operation disclosed by Hunt. Similarly, assuming in argument that Hunt in view of Williams and/or Nel teaches or suggests “automatically selecting one of said plurality of carrier entries based on an attribute of said demand entry; and automatically booking said selected carrier entry in response to said demand entry,” as claimed is not supported by the cited art. The Applicants again submit that there is no motivation to modify Hunt in view of Williams, and in further view of Nel, at least in part because Hunt teaches away from the suggested modification of “automatically selecting” and “automatically booking” a selected entry. Therefore, modification of Hunt by either of Williams and/or Nel would change the principle of operation disclosed by Hunt (see, col. 5, lines 61-65, col. 8, lines 22-24, col. 9, lines 21-24 and col. 9, lines 10-14 of Hunt).

For at least the foregoing rationale, Applicants respectfully submit that the rejection of Claims 1 and 30 under 35 U.S.C. §103(a) is not supported by the cited art.

Claims 20-25 and 29 depend from Claim 1 and recite additional features descriptive of embodiments of the present invention. Accordingly, the Applicants submit that the rejection of Claims 20-25 and 29 under 35 U.S.C. §103(a) are also not supported by the cited art.

Claims 36 and 40-42 depend from Claim 30 and recite additional features descriptive of embodiments of the present invention. Accordingly, the Applicants submit that the rejection of Claims 36 and 40-42 under 35 U.S.C. §103(a) are also not supported by the cited art.

CONCLUSION

In light of the above-listed remarks, reconsideration of the rejected claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 1, 3-30 and 33-42 overcome the rejections of record. Therefore, allowance of Claims 1, 3-30 and 33-42 is respectfully solicited.

Should the Examiner have a question regarding the instant response, the Applicants invite the Examiner to contact the Applicants' undersigned representative at the below-listed telephone number.

Respectfully submitted,
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